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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re the reissue application of: |) | |
| |) | |
| Don A. Perry and H. Earl Wright |) | |
| |) | |
| Title: Touch Enhancing Pad |) | Art Unit 335 |
| |) | |
| Serial No. 07 / 337,253 |) | Examiner: R. Shay |
| |) | |
| Filed April 13, 1989 |) | |

APPEAL BRIEF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the Final Rejection dated October 16, 1991.

STATUS OF CLAIMS

Claims 1 to 11 and 14 are rejected and are on appeal. Claims 12 and 13 were previously canceled.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the Final Rejection.

SUMMARY OF THE INVENTION

The invention is a pad which enhances the sense of touch when placed between the fingertips of the user and the object being touched. The pad

comprises an enclosure of a relatively thin, strong, pliable, and elastic material with a liquid lubricant sealed within. The properties of the enclosure and the lubricant are described in detail below with references to the page and line number of the specification. The pad is manufactured and sold under the trademark *Sensor Pad*® by Inventive Products, Inc., the assignee of the invention and of this application. The pad has been marketed primarily as an aid for women in performing breast self-examinations. Since its introduction in April, 1988, over 300,000 pads have been sold worldwide.

As will be seen, the critical characteristic of the pad for purposes of this appeal is the number of pieces of material forming its enclosure. In the first embodiment of the invention recited in claims 1 to 11, the enclosure is formed of a *single* piece of material (p. 3, lines 51-53). In the second embodiment of the invention recited in claim 14, the enclosure is formed of a *plurality* of pieces of material (p. 3, line 50).

The pad's enclosure has a wall thickness of about 0.005 to 0.020 inches (p. 3, lines 31-32) and a modulus of elasticity at 300 percent elongation of less than about 1,500 psi (p. 3, lines 40-42). It has a tensile strength of greater than about 3,000 psi (p. 3, lines 29-30) and an ultimate elongation of greater than about 400 percent (p. 3, lines 46-48).

The liquid lubricant sealed inside the enclosure has sufficient lubricity to reduce the coefficient of kinetic friction between the interior walls of the enclosure by at least about 60 percent (p.4, lines 26-28). This reduction of friction enables the top wall of the enclosure to move freely with the fingertips while the bottom wall remains stationary over the object being touched (p. 3, lines 12-15). The lubricant has substantial inertness towards the enclosure (p. 4, lines 35-37) and has a sufficiently-high resistance to mass transfer through the enclosure so that the amount of lubricant inside the enclosure remains substantially constant over time (p. 4, lines 28-32). The lubricant is present in an amount sufficient to fully coat the interior of the enclosure and yet small enough so that the enclosure can be flattened with at least about 75 percent of the surface area of one wall in contact with the other wall with only a minimum layer of lubricant between the walls (p. 4, lines 41-48).

ISSUES

Is the reissue declaration defective under 37 C.F.R. §1.175(a)(5) for failure to mention the species recited in claim 14, namely, a touch enhancing pad having an enclosure made from “a plurality of pieces” of material?

Is the reissue declaration defective under 35 U.S.C. §251 for failure of the original patent to evidence an intent to claim the species recited in claim 14, namely, a touch enhancing pad having an enclosure made from “a plurality of pieces” of material?

GROUPING OF CLAIMS

The rejections based on the reissue declaration apply to all the claims.

ARGUMENT

1. Prosecution History

The two issues on appeal pertain to the use of the phrase “a plurality of pieces” in describing the enclosure of the touch enhancing pad embodiment recited in claim 14, the only claim in this reissue application not present in the original patent (U.S. Pat. No. 4,657,021, hereafter the “Patent”). The Examiner’s first rejection is apparently based on the allegation that this phrase was not mentioned in the reissue declaration and the second rejection is based on the allegation that the Patent failed to evidence an intent to claim this particular embodiment. Accordingly, before addressing the two rejections, it is important to review the prosecution history of the Patent and of this reissue application with a focus upon the use of the phrase “a plurality of pieces.”

At the time the original application was filed, the Appellants believed that the preferred enclosure for the touch enhancing pad was a single piece of natural latex rubber. Latex rubber possesses unique properties of strength, pliability, and elasticity which the Appellants discovered were essential for touch enhancement. However, latex rubber cannot be effectively heat sealed or

glued. Therefore, an enclosure made of more than one piece of latex rubber would require a bulky, physical seal of some type. Various synthetic materials *are* heat sealable, but none had been found with the properties necessary for touch enhancement. Reflecting the Appellants' knowledge at the time, the specification stated, "Although *a plurality of pieces* can be joined together to form the enclosure, it is preferred that the enclosure be formed of a single piece of material because the presence of a seam of any type tends to interfere with the movement of the pad during use." (Emphasis added).

Original claim 1 did not specify the number of pieces of material in the enclosure. Accordingly, this claim included enclosures made from a single piece of material as well as enclosures made from a plurality of pieces, *i.e.*, two or more pieces, of material. During prosecution of the Patent, claim 1 was amended by adding a recitation that the enclosure was made of a *single* piece of material. The application was allowed and the Patent issued on April 14, 1987.

Sales of the *Sensor Pad*® touch enhancing pads were begun in early 1988. The original pads had enclosures of a single piece of natural latex rubber. Shortly thereafter, Inventive Products, Inc. became aware of a synthetic polyurethane film with properties of strength, pliability, and elasticity similar to those of latex rubber and within the ranges recited in the claims of the Patent. Unlike latex rubber, this polyurethane film *could* be heat-sealed. For a number of reasons, Inventive Products, Inc. decided in late 1988 to change the enclosure of the *Sensor Pad*® from one piece of latex rubber to two pieces of heat-sealed polyurethane. With the change to a two-piece enclosure, the Appellants found that the claims in the Patent could be interpreted as not literally reading upon the commercial product. As a result, a decision was made to file a broadened reissue application.

This broadened reissue application was filed with two claims in addition to the 11 claims in the Patent. Claim 12 recited a touch enhancing pad with an enclosure made of "a plurality of pieces" of material. Claim 13, which was dependent upon claim 12, recited that the touch enhancing pad was made of "two pieces" of material. In the first Office Action, the Examiner rejected the claims as being based upon a defective reissue declaration and listed a number

of alleged defects. In response, the Appellants submitted an amended reissue declaration.

The Examiner again rejected the claims as being based upon a defective reissue declaration. The amended reissue declaration was, according to the Examiner, defective because it violated the "recapture rule." The Examiner also rejected claims 12 and 13 under 35 U.S.C. §103 as being unpatentable over two prior art references.

The Appellants canceled claim 13 and amended claim 12 by substituting "consisting essentially of" for "comprising" in the transition and by substituting "two pieces" for "a plurality of pieces" in describing the number of pieces in the enclosure. After a Final Rejection, an appeal was made to the Board of Patent Appeals and Interferences.

In a decision dated August 23, 1991, the Board reversed the Examiner's rejections based upon the "recapture rule" and Section 103. However, under the provisions of 37 C.F.R. §1.196(b), the Board made a new rejection based on 35 U.S.C. §251. The Board stated that there was nothing in the Patent evidencing an "intent to claim" a touch enhancing pad having an enclosure made from *two* pieces of material, citing *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942). The Board noted that, while the specification *did* disclose a first species having an enclosure made of one piece of material and a second species having an enclosure made of a plurality of pieces, it did *not* specifically mention a two-piece enclosure. As stated on page 9 of the decision,

There is simply nothing in the original patent to suggest that the appellants intended to claim a species wherein the enclosure was made from two pieces of material.

However, dicta in the Board's decision seemed to suggest that, even had claim 12 recited "a plurality of pieces," the "intent to claim" rule would have been violated.

The Appellants interpreted the Board's decision as holding that, had claim 12 recited an enclosure made of a "plurality of pieces" rather than of "two" pieces, the "intent to claim" requirement would not have been violated. Accordingly, the Applicants filed an Amendment under 37 C.F.R. §1.196(b)(1) canceling claim 12 and adding claim 14 which recited an enclosure made of a

“plurality of pieces.” Claim 14 was identical to claim 12 as originally filed in the reissue application. The Examiner disagreed with the Appellants’ interpretation and made a Final Rejection of the claims based on 35 U.S.C. §251 for violation of the “intent to claim” requirement. The Examiner also rejected the claims under 37 C.F.R. §1.175(a)(5) because the reissue declaration allegedly makes no mention of an enclosure having a plurality of pieces. This appeal followed.

2. The 37 C.F.R. §1.175(a)(5) Rejection

In the Final Rejection dated October 16, 1991, the Examiner stated:

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. §1.175(a)(5). The declaration makes no mention of the changes in new claim 14.

Paragraph (a)(5) requires the reissue applicant to “particularly” specify “the errors relied upon, and how they arose or occurred.” According to Section 1414.03 of the Manual of Patent Examining Procedure, it follows from this paragraph that “[a]ny change or departure from the original specification or claims represents an ‘error’ in the original patent under 35 U.S.C. 251 and must be addressed in the original, or supplemental reissue oath or declaration.” Accordingly, the Examiner’s rejection is apparently that new claim 14 is a “change” from the original reissue claims and, therefore, must be “addressed” in a supplemental reissue oath or declaration.

As discussed above, “new” claim 14 is identical to claim 12 as originally filed in this reissue application. In other words, there is no “change” from the original reissue claims. The Examiner made no rejection based on Section 1.175(a)(5) at the time original claim 12 was pending. If there were not a Section 1.175(a)(5) problem with claim 12 then, there should be no problem with claim 14 now. The Appellants are unaware of any basis for a rejection made simply because a claim is amended to restore it to its original form.

3. The 35 U.S.C. §251 Rejection

The Examiner rejected the claims under 35 U.S.C. §251 because there was allegedly no intent in the Patent to claim the species having an enclosure made from a plurality of pieces of material- the species recited in claim 14. As discussed above, the specification specifically discloses an enclosure made from a plurality of pieces and claim 1 in the original application was generic in that it included enclosures made from one, two, or more pieces of material. Accordingly, even if there *were* an "intent to claim" requirement, the requirement is met in this case. However, if it were not clear before, the December 31, 1991 decision of the Court of Appeals for the Federal Circuit in *In re Amos*, ___F.2d___ (Fed. Cir. 1991), makes it now clear that this rejection is unfounded and should be reversed.

From 1832 to 1952, the reissue statute limited reissues to the "same invention" as the original patent and the courts applied this requirement strictly. See generally D. S. Chisum, *Patents* §15.03[3] (1991). For example, in *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942), the Supreme Court held that:

It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.

315 U. S. at 676.

When the 1952 Patent Act was enacted, Section 251 used the phrase "the invention disclosed in the original patent" in place of "the same invention." However, some courts continued to carry forward the "intent to claim" requirement until the Court of Appeals for the Federal Circuit, in a series of decisions beginning with *In re Hounsfield*, 699 F.2d 1320 (Fed. Cir. 1983), recognized the change brought about by the 1952 Act. The latest in this series of cases, *In re Amos*, makes it clear that the "intent to claim" requirement has been laid to rest.

In re Amos involved a patent claiming a set of lifting rollers. According to the specification, the lifting is accomplished "either mechanically by the

roller cams or electronically by [a] computer.” However, the original claims were not directed to the use of a computer. The broadened reissue application was filed to include claims directed to controlling the rollers by computer. As it did in its first decision with this application, the Board rejected the Amos reissue application for failure of the original patent to evidence an “intent to claim” the species added to the reissue application.

The Court of Appeals reversed the Board. The Court first noted that *In re Hounsfield* had established that lack of an “intent to claim” is not an independent basis for denying a reissue application under Section 251. The Court then went on to hold that the essential inquiry under the “original patent” clause of Section 251 is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In other words, the standard is whether the patentee “could fairly have claimed the newly submitted matter in the original application.”

In the *In re Amos* case, there was no question that the inventors *could* have claimed rollers with computer control, because the specification specifically mentions computer control. By the same token, the Appellants specifically mentioned an enclosure made from a “plurality of pieces” in their original specification and, therefore, certainly *could* have claimed that species in the original application. Accordingly, the “original patent” clause of Section 251 permits the Appellants to now claim this species in this reissue application and the Examiner’s rejection should be reversed.

CONCLUSION

The rejection based on 37 C.F.R. §1.175(a)(5) is unfounded because new claim 14 is identical to claim 12 as originally filed and, therefore, there is no “change” from the original reissue claims.

The rejection based on 35 U.S.C. §251 is in error because: (1) Lack of an “intent to claim” is not an independent basis for denying a reissue application; and (2) In the original Patent, the Appellants *could* have claimed the embodiment having an enclosure made from a “plurality of pieces” because that embodiment was specifically mentioned in the specification.

The Appellants request the Board of Patent Appeals and Interferences to reverse the Final Rejection of the Examiner and to allow claims 1 to 11 and 14.

Respectfully submitted,

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CERTIFICATE OF MAILING

Philip L. Bateman certifies that three copies of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on March 12, 1992.

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